

Attorney Docket No.: ISPH-0518  
Inventors: Baker et al.  
Serial No.: 09/695,451  
Filing Date: October 24, 2000  
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claimed each target and modulate expression of the same gene, TNFR1, the sequences are structurally and functionally independent and distinct as each SEQ ID NO. is a unique nucleotide sequence, and each sequence targets different and specific regions of the TNFR1 gene to varying degrees. The Examiner suggests that a search of more than one of the identified antisense sequences presents an undue burden on the Patent and Trademark Office. The Examiner has required Applicants to elect one sequence. Applicants respectfully traverse this restriction requirement.

MPEP §803 is quite clear; for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

All of claims of the instant application relate to the single concept of TNFR1 modulation. Further, all of the identified SEQ ID NOS of claims 3 and 4 share the ability to modulate a common

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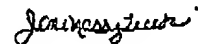
structure, namely the TNFR1 gene. Accordingly, each of the claims contain the components for use in the same endpoint, namely modulation of TNFR1 expression via an antisense compound. Thus, Applicants respectfully disagree that the Groups set forth by the Examiner are distinct as being novel and unobvious over each other, as required by MPEP § 802.01. Further, a single search relating to TNFR1 modulation would identify art related to all of the claims of this application and would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper. Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute SEQ ID NO: 1, with traverse. Claims 3 and 4 have been canceled. Claim 1 has been amended to clarify that the claimed invention is a compound targeted to a specific region of a species of the TNFR1 namely, SEQ ID NO: 1. Support for this amendment is found throughout the specification, at pages 57-59 and Table 3. Applicants believe that this election satisfies the instant Restriction Requirement.

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Attached hereto is a marked up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings to Show Changes Made."

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claims 3 and 4 have been canceled.

Claims 1 has been amended as follows:

1. (Amended) An antisense compound 8 to 30 nucleobases in length targeted to nucleobases 727-1310 of a nucleic acid molecule encoding TNFR1 (SEQ ID NO:1), wherein said antisense compound inhibits the expression of TNFR1.